IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants:	Travis J. Parry
Title:	METHOD AND SYSTEM FOR ONLINE PRINTER ERROR DATABASE
Appl. No.:	10/006,637
Filing Date:	11/08/2001
Examiner:	Winder, Patrice L.
Art Unit:	2145

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REPLY BRIEF ON APPEAL

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Sir:

This Reply Brief is in response to the Examiner's Answer mailed on March 5, 2008. For the following reasons, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims be issued.

I. The Examiner's Rejection of Claims 7, 8, 9, 21, 26 and 27 under 35 U.S.C. § 112, First Paragraph Should Be Reversed Because the Originally Filed Specification Evidences Possession of the Invention Set Forth in Claims 7, 8, 9, 21, 26 and 27

The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as claimed. See, e.g., *Vas-Cath, Inc.*,

935 F.2d at 1563-64, 19 USPQ2d at 1117. The burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an Appellant's disclosure a description of the invention defined by the claims rests with the examiner. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. The Examiner has failed to satisfy this burden. Accordingly, the rejection of the claims under 35 U.S.C. § 112, first paragraph is improper and should be reversed.

A. Claims 7, 8, 9, 21 and 26

Claims 7, 8, and 9 each recite that an error message is automatically conveyed over a network with a web server automatically in response to detection of an error. Claim 21 and 26 recite that an error message is automatically conveyed to at least one online error database upon detection of an error.

1. The specification contains a written description of the automatic conveyance of an error message upon detection of an error.

Support in the originally filed specification for such claim limitations is as follows:

> Only a small sample of errors and problems are reported to service providers or manufacturers. Errors that are relatively (sic) easy for a user to remedy may never be reported, even if they may occur frequently. Even in-depth testing of individual printers may fail to show a pattern of errors that is common for that printer model, in actual use. The ability to **AUTOMATICALLY** gather actual information on common printer errors for a large number of similar printers would constitute an improvement in the art.

(Paragraph [005]) (Emphasis added). This citation is from the Background Section and provides context the example embodiment which provides:

> **[0028]** If error detector 23 detects an error at any of the error detecting steps, an error message is generated as shown in box E4. The error message may be generated by the error detector 23, or by the web server 12. In some preferred embodiments, the error message

> is then written into an internal error log that is kept in the memory 22 of the printer 10.
>
> **[0029]** Web server 12 **then** uses microprocessor 20 to convey the error message to an online error database 60. If necessary, web server 12 may be used to convert the error message into an appropriate format, such as an HTML file or an email message. Web server 12 then conveys the error message, in appropriate format, as one or more data packages (in accordance with a transfer protocol such as IP or TCP) to the network address of computer 42. In an embodiment, such as that depicted in FIG. 3, this requires the data packets to be conveyed through network interface 16 and network 30, over the internet to I/O interface 46 of computer 42. Computer 42, which is preferably a network server, receives and assembles the data packet into the error message which is stored in the online database 60 in memory 52. Preferably, the reception and assembly is accomplished by microprocessor 50.

(Paragraphs [0028] and [0029]) (Emphasis added).

Appellant wishes to specifically point out that nowhere does this portion of the specification mention any intervening triggering steps or conditions that must be satisfied before the error message is conveyed to the online error database. For example, a person is not required to ADDITIONALLY request transmission of the error message. Thus, the conveyance of the error message is automatic -- addressing the exact need prescribed in the background section.

2. The Examiner has failed to establish that the written description does not describe automatic conveyance of an error message upon detection of an error.

Once again, the Examiner has the burden of establishing by a preponderance of evidence that a person skilled in the art would not recognize in Appellant's disclosure the conveyance of an error message over a network automatically in response to detection of an error. The Examiner has failed to satisfy this burden. However, in trying to satisfy this burden, the Examiner makes several failed attempts to mischaracterize what is actually taught by Appellant's originally filed application.

First, the Examiner attempts to argue that the context of the recitation "automatic" in Appellant's disclosure is limited to collecting error messages and not sending error messages. In particular, the Examiner argues:

> The context of the paragraph cited does not convey "automatically" as recited by Appellants' claim language. The "automatic" action refers to collecting "error messages" not sending "error messages". Therefore, Appellants' specification does not support "automatically" in the context associated with the claim language.

(Examiner's Answer, top of page 7)

The Examiner's assertion is simply NOT true. The portion of the Specification which specifically uses the word "automatic" recites in full:

> Only a small sample of errors and problems are reported to service providers or manufacturers. Errors that are relatively (sic) easy for a user to remedy may never be reported, even if they may occur frequently. Even in-depth testing of individual printers may fail to show a pattern of errors that is common for that printer model, in actual use. The ability to **AUTOMATICALLY** gather actual information on common printer errors for a large number of similar printers would constitute an improvement in the art.

(Paragraph [005]) (Emphasis added). In contrast to the Examiner's assertion, it is clear that the "automatic" action also refers to the reporting or conveyance of error messages. In fact, the Examiner's position makes little sense. It stands to reason that information on printer errors cannot be gathered from a large number of printers without the information **first** being sent, reported or conveyed. For information to be "automatically gathered" it must be "automatically reported."

Second, despite the clear meaning of Paragraph [0028] and [0029] in the context of the above Paragraph [005], the Examiner attempts to argue that the "if-then" description in Paragraphs [0028] and [0029] of Appellant's disclosure does not mean that error messages are automatically conveyed upon their detection. (See Examiner's Answer, page 6). The Examiner argues:

> By using the terminology then Appellant specification, the broadest reasonable interpretation is hinges on the acceptable meanings of "then". The term "then" would comprise a next step for action needs to be performed. However, "then" includes that the next step is performed with or without delay. Also, "then" does not exclude possible intervening steps. The "broadest reasonable interpretation is consistent with the specification".

(Examiner's Answer, page 6).

However, The Examiner's position lacks merit for at least two reasons: (1) the Examiner fails even apply the correct meaning to the term "automatic" and (2) the Examiner improperly focuses on a single word "then" while ignoring Appellant's actual disclosure surrounding the word "then."

(1) Automatic does not mean instantaneous.

The Examiner argues that the limitation "then" includes that "the next step is performed with or without delay." The Examiner appears to be confusing the meaning of the limitation "instantaneously" with the limitation "automatically." They are not the same. Although the limitation "instantaneously" would mean "without delay," an action may be automatic despite a built-in delay. In contrast to the Examiner's applied meaning, one of ordinary skill in the art understands that the term "automatic" means that no further conditions must be satisfied or triggering events must occur before the action is initiated. As clearly set forth in Paragraph [0028] and [0029], if the error detector detects an error, **then** an error message is conveyed to an online error database. No intervening conditions must be satisfied. No additional triggering events are required. The conveyance is "automatic."

(2) The Examiner's attempt to focus on the one word "then" and apply a meaning to the word that is inconsistent with the specification is improper.

The Examiner improperly focuses on the one-word "then" and improperly tries to apply a meaning to the term that is NOT consistent with the surrounding portions of the specification. The Examiner tries to assert that the "broadest reasonable interpretation" of the term "then" recited in Paragraph [0029] of the specification

encompasses both (A) actions that are automatic and (B) actions that are not automatic, i.e. actions which are not initiated until an additional condition or trigger event takes place. (See Examiner's Answer, page 6).

However, even assuming, arguendo, that the "broadest reasonable interpretation" of the term "then" asserted by the Examiner is correct, i.e. that the term "then" can have either of the two meanings, so what. The specification only describes one of the two potential meanings asserted by the Examiner for the term "then." The specification only describes actions that are automatic. The specification does not describe a method which requires intervening additional conditions or which requires trigger events to be satisfied before the error message is conveyed.

The bottom line is that the determination of what the specification discloses does NOT hinge on the acceptable meaning of "then" as alleged by the Examiner. Rather, the determination of what the specification discloses and whether the claim limitations are supported by the specification depends on what the entirety of the paragraphs disclose. The entirety of paragraph [0028] and [0029] describe a method and system wherein upon detection of an error, an error message is conveyed to an online error database without any additional intervening conditions and without triggering events needing to be satisfied. Said in one word, the conveyance of the error message is "automatic." Accordingly, rejection of claims 7, 8, 9, 21 and 26 under 35 USC 112, first paragraph, should be reversed.

B. Claim 27

Claim 27 recites a method in which different printers having web servers convey generated error messages to distinct online error databases depending upon the model type or set of software programs of the printers. In other words, the first printer of a first model type or running a first set of software programs conveys error messages to a first online error database while a second printer of a second model type or running a second set of software programs conveys error messages to a second distinct online error database.

1. The specification contains a written description of different printers having web servers that convey generated error messages to distinct online error databases depending upon the model type or set of software programs running on the printers.

Support in the originally filed specification for such claim limitations is as follows:

> **[0032]** The error messages from a number of printers 10 may be all conveyed to the same network address, allowing the online database 60 to contain error messages from any number of printers. Alternatively, a number of different IP addresses may be used, allowing for a number of online databases to be maintained. It is preferred that **if a number of different databases are kept, each database 60 will receive and contain information from a number of printers that are selected in various ways.** This may be accomplished through the providing of each database 60 with separate IP addresses, among other possibilities. For example, **only printers of a certain model may convey error messages to one database 60**. Alternatively, **only printers running certain software programs may send error information to a particular database 60**. A single printer 10 may send error information to one or more databases 60 at the same time.

(Specification, Paragraph [0032]) (Emphasis added).

2. The Examiner has failed to establish that the written description does not describe different printers that convey generated error messages to distinct online error databases depending upon the model type or set of software programs of the printers.

Once again, the Examiner has the burden of establishing by a preponderance of evidence that a person skilled in the art would not recognize in Appellant's disclosure a method or a system in which different printers convey generated error messages to distinct online error databases depending upon the model type or set of software programs running on the printers. The Examiner has failed to satisfy this burden. However, in trying to satisfy this burden, the Examiner makes several failed attempts to mischaracterize what is actually taught by Appellants' originally filed application.

In the Examiner's Answer, the Examiner argues:

> The disclosure does not provide guidance on whether he different software program is associated with a different database. The specification is silent as to the exact permutations of the arrangement that would be available. For example possible permutations are: a software program sends a corresponding database, each software programs sense to all the databases or some software programs sent to some databases. Appellant's disclosure at paragraph [0032] does not associate the software programs with specific databases. Appellant must consider the difference is conventional because the disclosure was not written to include specific permutations. Therefore, the new matter of Appellant's disclosure is "a first program" that performs a specific function and any "second program" that performs a different function, not the concept of "a first software program" and "a second software program".

(Examiner's Answer, pages 7-8).

Appellant does not see the relevancy or merit to the Examiner's arguments. First, Appellants' do not understand how the "exact permutations of arrangement" is even relevant to the issue at hand as to whether the specification discloses different printers that convey generated error messages to distinct online error databases depending upon the model type or set of software programs of the printers. Again, what matters is what the disclosure states, not what permutations the Examiner can creatively come up with and improperly argue that the disclosure is lacking for not describing each of the permutations thought up by the Examiner.

What is clear is that the disclosure describes different printers that send error messages to different online error databases depending upon the model type or the software programs running on the printers. Paragraph [0032] specifically states that:

> **If a number of different databases are kept, each database 60 will receive and** contain **information from a number of printers that are selected in various ways.**

This sentence, said in another way, states that if multiple databases are utilized, each database receives information from selected printers. In other words, each database does not receive information from all of the printers. Some databases receive information from some printers while other databases receive information from other printers. Thus, the second "permutation" thought up by the Examiner ("each software program sends to all the databases") is irrelevant. The other two "permutations" thought up by the Examiner are actually the same and are actually both what is disclosed by the specification and what is being claimed -- different printers that convey generated error messages to distinct online error databases depending upon the model type or set of software programs run by the printers.

Second, Appellant does not understand the relevancy of whether Appellant considers certain differences to be conventional. 35 USC Section 112, First Paragraph, does not require a patent applicant describe every permutation that may exist. In contrast, the law only requires a patent applicant to describe what is being claimed.

Third, the Examiner now appears to be changing the basis for the rejection of claim 27 under 35 USC Section 112, First Paragraph. The Examiner now appears argue that the disclosure does not disclose different printers running different software programs. This new basis also lacks merit. Paragraph [0032] simply states:

> Alternatively, only printers running certain software programs may send error information to a particular database 60.

This clearly describes different printers running different software programs. Obviously, if all the printers were running the same software program, the above quoted sentence would make absolutely no sense. Clearly, some printers are running some software programs and other printers are running other software programs. What software programs are being run by a particular printer determines whether the particular printer sends error information to a particular database. This

can't be more clear. Accordingly, the rejection of claim 27 under 35 USC Section 112, First Paragraph should be reversed.

II. The Examiner's Rejection of Claims 21 and 26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,438,004 (Bernklau-Halvor) Should be Reversed Because Bernklau-Halvor Does Not Include Every Limitation of Each of the Claims.

Claim 21 is directed to a system for garnering information on printer errors. The system includes a plurality of printers with each of the printers incorporating a web server and an error detector for detecting errors in printing functions. The system further includes at least one receiving computer and at least one online error database capable of receiving an error message generated by any of the plurality of printers. Each printer is configured to **automatically generate and convey** the error message over a network to the least one online error database upon detection of an error.

Claim 26 is directed to a method which includes detecting a first error at a first printer incorporating first Web server, generating a first error message at the first printer and conveying the first error message to the first online database with the first Web server over a network. The method further includes detecting a second error and a second printer incorporating a second Web server, generating a second error message at the second printer and conveying the second error message to the first online error database with the second Web server over a network. Claim 26 specifically recites that first error message is **automatically conveyed** to the online error database in response to detection of the first error.

As previously noted in the Appeal Brief, Bernklau-Halvor fails to disclose a system having an error database that receives error messages from multiple printers, wherein error messages are automatically generated and conveyed over a network to the least one online error database upon detection of an error. In contrast, Bernklau-Halvor only transmits the usage profile record after the user has specifically requested support for the printer. (See column 2, lines 21-65). Until

such a request is made by the user, the usage profile information is, at most, stored in the printer itself. (See column 4, lines 46-50; column 5, line 16-18). Column 4, lines 50-55 specifically states:

> when a request for service is made to the supply server 12, the support server will request any usage profile information stored about the printer to be sent to it for analysis. Alternatively, the printer may send the usage profile information with the request for support.

(Emphasis Added).

Examiners Answer

In response to such points raised in the Appeal Brief, the Examiner now attempts to just ignore the actual limitations of claims 21 and 26 by seemingly arguing that Bernklau-Halvor anticipates claims 21 and 26 because Bernklau-Halvor discloses automatically generating error messages. However, in direct contrast, the claims recite the automatic **conveyance** of the error message, not simply generation of the error message. As noted above, Bernklau-Halvor does not disclose the automatic conveyance of error messages. In contrast, Bernklau-Halvor requires an additional intervening triggering action, namely, a person specifically requesting transmission of the error message. The **conveyance** of an error message is **not** automatic in Bernklau-Halvor. The Examiner's arguments cannot avoid this plain and simple fact. Accordingly, the rejection of claims 21 and 26 is improper and should be reversed.

Conclusion

In view of the foregoing, the Appellant submits that Claims 7, 8, 9, 21, 26 and 27 are not properly rejected under 35 U.S.C. § 112, first paragraph as failing to satisfy the written description requirement and are therefore patentable. Claims 21 and 26 are not properly rejected under 35 U.S.C. § 102(e) as being as being anticipated by U.S. Patent No. 6,782,495 (Bernklau-Halvor) and are therefore patentable. Accordingly, Appellant respectfully requests that the Board reverse the

rejections of claims 7, 8, 9, 21, 26 and 27 and indicate that a Notice of Allowability respecting such pending claims should be issued.

Summary

For the foregoing, it is submitted that the Examiner's rejections are erroneous, and reversal of the rejections is respectfully requested.

Dated this 5th day of May, 2008.

Respectfully submitted,

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